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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,408	11/19/2003	Mark Meister	3222.1320001	5313
26111 7590 07/22/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
LIM, KRISNA				
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2153				
MAIL DATE		DELIVERY MODE		
07/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/715,408

**Applicant(s)**

MEISTER ET AL.

**Examiner**

Krisna Lim

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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1. The amendment filed 3/25/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a) The phrase "not created by a user" was replaced by "created by an unauthorized process." By changing the claimed language from "not created by a user" to "created by an unauthorized process", the scope and meaning of the claimed language are totally different and specifically this change was not supported in the original specification. At paragraphs 12, 13, 16, 18, 26 and 28 of the original specification as argued by the applicants do not clearly teach that a complete e-mail message was created by an unauthorized process. The specification only mentions that the present invention will alert a user when an unauthorized e-mail message is being sent. Therefore, there is no teaching of a complete e-mail message was created by an unauthorized process.

b) The phrase "an agent" was replaced by "the unauthorized process". By changing the claimed language from "an agent" to "the unauthorized process", the scope and meaning of the claimed language are totally different and specifically this change was not supported in the original specification.

c) The following text: "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message" is not support in the original specification. Mention of "unauthorized" messages and/or e-mails at paragraphs 12, 13, 16, 18, 26, and 28 does not teach the newly added claimed language of "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message".

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Applicant is required to cancel the new matter in the reply to this Office Action.

2. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-13, drawn to an e-mail system comprising the step of:

recognizing whether a complete electronic mail message created by an unauthorized process, classified in class 709, subclass 206.

II. Claims 14, 22-22, drawn to an e-mail system and a method

comprising the step of determining whether an electronic mail message having at least a minimum of parts needed to be a valid electronic mail message and by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message is to be sent, classified in class 709, subclass 206.

III. Claims 15-20, drawn to an e-mail system and a method comprising

the step of: recognizing whether a complete electronic mail message by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message and having a valid recipient address is to be sent, after a send function has been initiated, from a sending side to a receiving side, classified in claim 709, subclass 206.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombination is distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group II has separate utility such as an e-mail system and a method comprising the step of determining whether an electronic mail message having at least a minimum of parts needed to be a valid electronic mail message and by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message is to be sent. And it does not require the step of recognizing whether a complete electronic mail message created by an unauthorized process. See MPEP § 806.05(d). The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombination is distinct if they do not

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overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group III has separate utility such as an e-mail system and a method comprising the step of: recognizing whether a complete electronic mail message by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message and having a valid recipient address is to be sent, after a send function has been initiated, from a sending side to a receiving side. And, it does not require the step of recognizing whether a complete electronic mail message created by an unauthorized process. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombination is distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one

subcombination is separately usable. In the instant case, subcombination Group III has separate utility such as an e-mail system and a method comprising the step of: recognizing whether a complete electronic mail message by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message and having a valid recipient address is to be sent, after a send function has been initiated, from a sending side to a receiving side. And it does not require the step of determining whether an electronic mail message having at least a minimum of parts needed to be a valid electronic mail message and by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message is to be sent. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. In the remark filed on 3/25/08, the applicants argued that:

a) The phrase "not created by a user" was replaced by "created by an unauthorized process." This amended claim language finds support in the specification, as the specification contains numerous references to "unauthorized" messages and/or e-mails. See U.S. Pat. Appl. Publ. 2004/0103162 at paras. 12, 13, 16, 18, 26, and 28. Moreover, the specification underscores that "computer viruses can compose and send e-mail without a user being aware of the transmission of such 'unauthorized' e-mail." See U.S. Pat. Appl. Publ. 2004/0103162 at para. 12. The use of the words "compose" and "send" establish that computer viruses are processes, and further establishes that such processes are "unauthorized" since the e-mail they produce is "unauthorized e-mail".

b) The phrase "an agent" was replaced by "the unauthorized process". See amended claims 2, 3, and 5 in the Office Action Reply dated May 29, 2007. As noted above, there are numerous references in the specification to "unauthorized" messages and/or e-mails, as well as the reference to computer viruses that are processes by virtue of their ability to "compose" and "send" such "unauthorized" e-mail.

c) The following text: "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message". Such claim language also finds support in the specification. As noted above, the specification contains numerous references to "unauthorized" messages and/or e-mails. See U.S. Pat. Appl. Publ. 2004/0103162 at paras. 12, 13, 16, 18, 26, and 28. Moreover, the specification underscores that "computer viruses can compose and send e-mail without a user being aware of the transmission of such 'unauthorized' e-mail." See U.S. Pat. Appl. Publ. 2004/0103162 at para. 12. Accordingly, "virus" has express support in the specification, and "an agent other than an owner of a mail client source of the message" has implicit support since actions by "an agent other than an owner" are "unauthorized". Moreover, "a trojan horse" also has implicit support since a "trojan horse" is understood by those of ordinary skill in the art to be: "Software that appears to do something normal but which contains a trap door or attack program. A Trojan Horse program can be used to break into a network



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through a World Wide Web site. A Trojan Horse is dangerous software." Harry Newton, Newton's Telecom Dictionary, p. 619, 11th ed., Flatiron Publishing, Inc., 1996. Therefore, the text "one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message" finds support in the specification.

d) As noted in the telephonic interview, the Examiner contends that claims 1-22 are directed to two "distinct" and "independent" inventions. They are as follows: Group I, claims 1-13, the "old" claims "directed to [an] email that is created by [an] [un]authorized process". Office Action at 2, with presumed error corrected as noted above.

Group II, claims 14-22, the "new" claims "directed to [an] email that is recognized by one of a virus, a trojan horse and an agent." Office Action at 2. Applicants respectfully submit that the Group I claims and Group II claims are not independent. "Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect." M.P.E.P. § 806.06. However, Applicants submit that the Group I claims and the Group II claims are connected in design, operation, and effect. Both groups of claims are directed to a system that alerts or warns a user of a pending e-mail transmission, such that e-mail addresses can be corrected or the e-mail transmission cancelled and thereby prevent unintended or unauthorized e-mail transmissions. Therefore, both groups of claims are connected in design (e.g., addition of a modify/cancel control), operation (display of dialog box to user), and effect (permits modification and/or cancellation of e-mail transmission). Accordingly, the Group I claims and the Group II claims are not independent.

Moreover, Applicants respectfully submit that the Group I claims and Group II claims are not distinct. The burden is on the Examiner to provide a prima facie case by way of an example that the claims do not overlap in scope, are not obvious variants, and are either not capable of use together or can have a

materially different design, mode of operation, function, or effect. M.P.E.P. § 806.05). Since no example has been provided in the Office Action to which a response can be made, Applicants submit that this concern should be withdrawn. Finally, even assuming, arguendo, that the two groups of claims are independent or distinct, Applicants respectfully submit that the Group I claims and the Group II claims should be examined together, since they are directed to similar, overlapping subject matter. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. Both Group I claims and Group II claims have similar features recited, which should encompass a similar search. For example, both groups deal with a process or apparatus that deals with suspending e-mail transmissions to enable a user to avoid inadvertent e-mail transmissions or to terminate unauthorized e-mails generated by viruses, etc. For at least this reason, a search of these two groups as claimed does not impose a serious burden upon the Examiner. Accordingly, reconsideration and withdrawal of the Examiner's contention that the two groups of claims are independent or distinct is thereby respectfully requested.

6. As to paragraph 5 a) above, see paragraph 1 a) above. Yes, the computer viruses can compose and send e-mail without a user being aware of the transmission of such 'unauthorized' e-mail. However, Examiner disagrees that the use of words "compose" and "send" establish that computer viruses are processes, and further establishes that such processes are "unauthorized" since the e-mail they produce is "unauthorized e-mail." First of all, the process is the broader term and it is not automatically encompass "compose" and "send". If this is case why don't the applicants state so in the original application?

7. As to paragraph 5 b) above, see paragraph 1 above. It is not understood how the term "an agent" was replaced by the "the unauthorized process". If

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these two terms are use interchangeable, why don't the applicants state so in the original application?

8. As to paragraph 5 c) above, in short why don't applicants state so in the original applications? Original specification must state so as in the claimed language.

9. As to paragraph 5 d) above, each group of claim contains distinguished steps which are burden on the Examiner to search and examiner each of these distinguished steps. See paragraphs 2-5 for those distinguished steps.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956 The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

July 18, 2008

/Krisna Lim/

Primary Examiner, Art Unit 2153